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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/911,760	07/10/92	BARCLAY	W 2391-2

EXAMINER
PENLAND, R

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13M2

ART UNIT	PAPER NUMBER
1302	5

DATE MAILED: 04/06/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire One month(s), ___ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☑ Claims 9,14-36,42-49 and 53-68 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☑ Claims 9,14-36,42-49 and 53-68 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

1. The following is a supplemental restriction requirement in view of newly submitted claims 69-71:

Applicant has submitted new claim 69 directed to an invention that is independent or distinct from the invention elected by applicant in Paper No. 6, filed May 7, 1993 (i.e. claims 53-62 were elected) for the following reasons. Claim 69, which is drawn to an animal (classified in Class 800, subclass 2), does not appear to come within the boundaries set forth by 35 U.S.C. 101 which permits patents to be granted only for new and useful processes, machines, manufactures, or compositions of matter, or any new and useful improvement thereof. Clearly, the animal claimed does not fall under any of these categories including a manufacture. Method claim 9 (from which said animal results) only provides limitations drawn to feed material of an animal to increase its omega fatty acid content as it is being raised. Since the animal of which results from claim 9 would occur substantially unaltered in nature, said animal is simply not a manufacture. See Ex parte Grayson, 51 USPQ 413.

Applicant also submitted new claims 70 and 71 which are drawn to products. Elected product claims 52-63 and newly submitted claims 70 and 71 are directed to the following distinct species of the claimed invention:

Species A. Claims 70 and 71 are drawn to a food product from animals or produced by animals (i.e. animal flesh, chicken eggs)

which have been raised on a particular lipid feed.

Species B. Claims 52-63 are drawn to a food product comprising said lipid at a certain salinity and temperature and a food material.

Such are considered to be mutually exclusive. The food products of claims 70 and 71 do not require that said lipid be present at a certain salinity and temperature as set forth in claims 52-63. Moreover, claims 52-63 do not require said food product comprising a part of an animal or product of an animal which has been raised on said lipid. It should be noted that raising an animal occurs over time, and that the body of said animal would naturally deplete and modify said lipid over such a time, thus providing a substantially different product.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be

entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

During a telephone conversation with Gary J. Connell on August 4, 1993 a provisional election was made with traverse to prosecute, the invention of Species B, claims 53-62. Affirmation of this election must be made by applicant in responding to this Office action. Claims 69-71 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

2. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with

which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the claims as now recited. Specifically, the specification does not provide support for a sodium concentration of less than about 8.58. It should be noted that support does exist for "less than 6.58". In addition, the original specification does not provide support for said food material having an absence of a fishy odor. This is a new matter rejection.

Claims 56 and 62 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

3. Claims 53-62 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-5 and 7-10 of prior U.S. Patent No. 5,130,242. This is a double patenting rejection.

It should be noted that the rejection of claim 8 is with the presumption that the concentration set forth "8.58" is a typographical error which should be -6.58-. However, in the event that such is not a typographical error see the new matter rejection above and the obvious-type double patenting rejection below.

4. Claims 56 and 62 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 3, and 8 of U.S. Patent No. 5,130242. Although the

conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art to have employed a food material which is fish or has the odor of fish. An indefinite number of food materials do not have such an odor (meat, eggs, dough, etc.), and the use of foods other than those which possess a fish odor would have been an obvious determination dependent upon one's personal preference.

With respect to claim 56, if it is determined that the figure "8.58" is not a typographical error (discussed above), then it would have been well within the purview of one having ordinary skill in the art at the time of the invention to have determined said sodium concentration level through routine experimental optimization. See In re Boesch, 205 USPQ 215.

5. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is (703) 308-3846.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

8/6/93

Anthony Weier
August 6, 1993

Jeanette M Hunter

JEANETTE HUNTER
PRIMARY EXAMINER
ART UNIT 132